

**REMARKS**

**Summary of the Office Action**

In the Office Action, claims 1-8 are pending.

In the Office Action, claims 1 and 5 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,786,400 to Bucci ("Bucci"). Claims 2-3 and 6-7 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Bucci in view of U.S. Patent No. 6,834,269 to Bueche ("Bueche"). Claims 4 and 8 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Bucci and Bueche and further in view of US. Patent No. 6,353,811 to Weissman ("Weissman").

**Applicants' reply**

In this amendment and response, Applicants address the Examiner's rejections. Claims 1 and 5 have been amended to incorporate the features of canceled claims 2 and 6. Claims 3 and 7 have been amended to reflect new dependencies. Claim 4 has been amended to clarify the claimed subject matter. As such, no new matter has been added. This amendment is made solely to expedite prosecution and does not constitute acquiescence to any of the Examiner's objections or rejections. Applicants reserve the option to further prosecute the same or similar claims in a subsequent application. Upon entry of the Amendment, claims 1-8 are pending.

**Claim Rejections – 35 U.S.C. § 102(e)**

Claims 1 and 5 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Bucci.

Claim 1 is directed to a financial transaction payment system. Among other things, claim 1 features a depository account and a card for conducting transactions and incurring charges.

Additionally, as featured in claim 1, “a portion or all of said charges are deducted automatically from said depository account periodically.” As noted by the Examiner, Buccì does not disclose this feature. (See Office Action, page 3). As such, Applicants respectfully submit that claim 1 is allowable over Buccì. Independent claim 5 recites similar features and is allowable over Buccì for at least the same reasons.

Claim Rejections – 35 U.S.C. § 103(a)

Claims 2-3 and 6-7 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Buccì in view of Bueche. Claims 4 and 8 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Buccì and Bueche and further in view of US. Patent No. 6,353,811 to Weissman (“Weissman”). Claims 2 and 6 have been cancelled, and independent claims 1 and 5 have been amended to incorporate their features.

To reject claims in an application under Section 103, an examiner must establish a *prima facie* case of obviousness. Using the Supreme Court’s guidelines enunciated in *Graham v. John Deere*, 383 U.S. 1, 17 (1966), one determines “obviousness” as follows:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

In *KSR Int’l Co. v. Teleflex Inc.*, No. 04-1350 (U.S. April 30, 2007), the Supreme Court reaffirmed the *Graham* test, and indicated that although it should not be rigidly applied, a useful test for determining obviousness is to consider whether there is a teaching, suggestion or motivation in the prior art that would lead one of ordinary skill in the art to combine known elements of the prior art to arrive at the claimed invention. Importantly, the Court emphasized

that a patent examiner's analysis under Section 103 should be made explicit in order to facilitate review.

Thus, to establish a *prima facie* case of obviousness, the Examiner has an obligation to construe the scope of the prior art, identify the differences between the claims and the prior art, and determine the level of skill in the pertinent art at the time of the invention. The Examiner must then provide: (1) an explicit, cogent reason based on the foregoing why it would be obvious to modify the prior art to arrive at the claimed invention; (2) a reasonable expectation of success; and (3) a teaching or suggestion of all claimed features. See M.P.E.P. §§ 706.02(j) and 2143.

Claim 1 is directed to a financial transaction payment system. Among other things, claim 1 features a depository account and a card for conducting transactions and incurring charges. Additionally, as featured in claim 1, "a portion or all of said charges are deducted automatically from said depository account periodically," similar to features of canceled claim 2. No such combination is disclosed in or suggested by Bucci, Bueche, or Weissman, whether considered individually or in combination.

#### No Motivation to Combine

As an initial matter, Bucci is directed to a system and method that offers a consumer the option to conduct transactions using either a credit line or funds in an account. (*See* Bucci, Abstract). In contrast, Bueche describes a software-generated purchase key. (*See* Bueche, Abstract). Weissman describes a system and method for allocating all expenditures, accrued interest attributable to each expenditure, and payments made by respective credit cardholders, to sub-accounts specifically designated by the cardholder. (*See* Weissman, Abstract). The three

cited references are concerned with solving different problems, and there would be no reason or likelihood of success for one of ordinary skill to combine the teachings of Bucci with the teachings of either Bueche or Weissman. The Examiner has not established a prima facie case of obviousness for at least these reasons.

Independent Claims 1 and 5

Assuming, *arguendo*, that there was a reasonable likelihood of success and a motivation to combine Bucci and Bueche, the combination still would fail to disclose or suggest all elements of amended claim 1.

The Examiner alleges that Bueche discloses “deducting means for automatically deducting from said depository account periodically an amount to pay a portion or all of said charges,” similar to features in amended claim 1. Specifically, the Examiner cites column 4, lines 60-64 of Bueche. (*See* Office Action, page 3). Applicants respectfully disagree.

Applicants respectfully submit that Bueche *teaches away* from the features of independent claim 1. Specifically, Bueche describes, “[f]or instance, a purchaser could order a computer system, a pre-paid ISP service contract from an ISP provider, and a promotional offer of one free digital video movie stream from a commercial video rental provider. The purchaser may charge the computer system to her credit card ...have a monthly ISP service fee automatically deducted from her checking account, and receive the video stream free of charge.” (Bueche, col. 4, lines 56-64). In contrast, among other things, claim 1 features a depository account and a card for conducting transactions and incurring charges. Additionally, as featured in claim 1, “a portion or all of said charges are deducted automatically from said depository account periodically.” The automatic deductions described in Bueche are not associated with a card, as

featured in claim 1. Instead of teaching a portion or all of the charges associated with a card automatically deducted from said depository account periodically as featured in claim 1, Bueche describes “standard” card use when a customer uses a credit card to charge a computer system. (*See Bueche*, col. 4, lines 56-64). As such, the card payment described in Bueche teaches away from the features of claim 1.

While Bueche does describe automatic deductions from a checking account, it does not disclose or suggest deducting charges as featured in claim 1. Instead, Bueche describes bank account deductions in connection with a monthly service fee as part of a pre-paid service contract. (*See Bueche*, col. 4, lines 56-64). In claim 1, the deductions are used to pay a portion or all of the charges associated with specific credit card transactions periodically. In contrast, Bueche describes the use of monthly charges to pay a monthly service fee in connection with the pre-paid contract.

For at least these reasons, Applicants respectfully submit that claim 1 is non-obvious and patentable over Bucci in view of Bueche. Independent claim 5 contains similar features to those recited in independent claim 1 and should be allowed for at least these same reasons.

Claims 3, 5, and 6

Claims 3 and 6 depend from independent claims 1 and 5. As such, these claims are also allowable.

Dependent Claims 4 and 8

The Examiner alleges that, “Weissman teaches billing means operated by said second financial institution for periodically informing said consumer of said charges made on the card and of the amount received from said consumer depository account to cover said charges...” (Office Action, page 4). Assuming, *arguendo*, that this is the case, Weissman does not disclose

or suggest the features of independent claims 1 and 5 discussed above and fails to make up for the deficiencies of Buccì and Bueche with respect to these claims. Therefore, claims 4 and 8, which depend from independent claims 1 and 5 respectively, are also allowable for at least the reasons given above with respect to independent claims 1 and 5.

Based on the foregoing Amendment and Remarks, Applicants traverse Examiner's rejection of claims 1-8 under 35 U.S.C. § 102 and 35 U.S.C. § 103.

**CONCLUSION**

On the basis of the foregoing Amendments and remarks, Applicants respectfully submit that the pending claims of the present application are allowable over the prior art of record. Applicants thus respectfully request the previous rejections be withdrawn, and that the pending claims be allowed by the Examiner. Favorable consideration and timely allowance of this application are respectfully requested. In the event that the application is not deemed in condition for allowance, the Examiner is invited to contact the undersigned at (212) 408-2538 in an effort to advance the prosecution of this application.

Respectfully submitted,



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